

GP 2814

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PATENT, TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION

Docket: 0039-7292-2 DIV

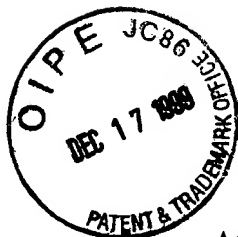
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Re: Serial No.: 09/358,388

Filed: JULY 21, 1999

Applicant: KAORI UMEZAWA, ET AL.

For: SUBSTRATE HAVING SHALLOW
TRENCH ISOLATION AND METHOD OF
MANUFACTURING THE SAME



Attached hereto for filing are the following papers:

RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT

Our check in the amount of \$_____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

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0039-7292-2 DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
KAORI UMEZAWA, ET AL ✓ : EXAMINER: MAI
SERIAL NO: 09/358,388 :
FILED: JULY 21, 1999 ✓ : GROUP ART UNIT: 2814
FOR: SUBSTRATE HAVING :
SHALLOW TRENCH ISOLATION ✓
AND METHOD OF MANUFACTURING ✓
THE SAME

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RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

SIR:

In response to the communication dated November 18, 1999, and further in response to the Election of Species Requirement contained therein, Applicants herein provisionally elect the "claim 9-15, group I" species noted in the Requirement (page 2) as being "directed to a process of forming a trench as described in the first embodiment, class 438 subclass 424" and further list Claims 9-15 as readable thereon.

In addition, Applicants respectfully traverse this Election of Species Requirement as violating the guidelines set forth in the MPEP.

The first guideline violated is presentation of claims as being species. As noted in MPEP §806.04(e) (July 1998):

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the

disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Species are always the specific different embodiments.

In addition to incorrectly indicating that specific claims constitute the disclosed species, the Requirement also violates MPEP guidelines because it ignores the application disclosure and the clear indication therein of the relatedness of what have been characterized as species. The disclosed and claimed combination and subcombination relationships must always be considered as noted in MPEP §806.04(b) (July 1998):

Species, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both practice applicable to Election of Species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05 - §806.05(i). If restriction is improper under either practice, it should not be required.

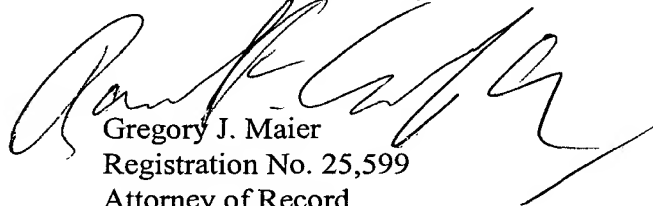
Here, it is clear that what has been characterized in the Requirement as the species of Claim 9, for example, is really directed to a subcombination method that is specifically recited as part of the method of combination Claim 16, for example, see steps (c)-(e). Note MPEP §806.04(f) (July 1998) which requires that claims to be restricted to different species must be mutually exclusive, which is not the case as to Claims 9 and 16 as demonstrated above.

In any event, since a combination - subcombination relationship exists as to Claims 16 and 9, it is clear that the Requirement is improper for failing to carry out the distinctness analysis required by MPEP §806.04(b) (July 1998) and MPEP §806.05(c) (July 1998) as to the existing relationship of combination (Claim 16) and subcombination (Claim 9).

Consequently, since the Election of Species Requirement presented is clearly at odds with the directives of the MPEP, it is submitted that this Requirement should be withdrawn and that an action on the merits as to all the pending claims should be forthcoming.

Respectfully submitted,

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